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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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INNOVATION
1001/0828
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| EXAMINER |
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MICHL, P

| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 08/28/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5-27-98 6-10-98
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-113 is/are pending in the application.
- Of the above claim(s) 31-59 is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-30, 60-113 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

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Claims 31-59 remain withdrawn from further consideration for being directed to the non-elected invention. Applicants' traversal of the restriction requirement is noted. However, the Examiner believes that the restriction requirement is proper and the restriction requirement is made FINAL. The two inventions are independent and distinct from one another. The apparatus may be used to process materials other than elastomer. The method of claims 1-30 and the composition of claims 60-113 may be conducted in apparatus other than that of claims 31-59.

The Examiner notes applicants' amendment to the specification that this application is a continuation-in-part of Serial No. 08/625,163. However, applicants have not claimed benefit under 35 U.S.C. § 112 in the Declaration and Power of Attorney. The Examiner suggests that applicants submit an amended Declaration and Power of Attorney claiming benefit for 08/625,163.

Applicants are requested to submit a copy of the allowed claims in 08/625,163.

Claims 1-31 and 60-113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kafka. Applicants' method claims are directed to a method of mixing elastomer latex with a fluid comprising filler and coagulating in a reactor. Kafka discloses mixing latex and aqueous slurry of filler in an extruder and coagulating. Applicants' claimed reactor encompasses the Kafka

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extruder. See the Abstract of Kafka. The Examiner presumes that the compositions recited in claims 60-112 are the products resulting from the method of claims 1-31 and 113. The difference between the claims and Kafka is that Kafka does not specifically recite macrodispersion. It would be obvious to one of ordinary skill in the art to incorporate fillers into elastomers according to Kafka in such a manner as to achieve compositions having the recited macrodispersion limitations of claims 60-112. The motivation is that it is within the skill in the art to impart the necessary energy into the Kafka extruder to achieve the desired degree of dispersing the filler into the elastomer.

Claims 60-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue or Asai or Simonet. These references disclose mixing elastomer and filler to achieve macrodispersion. The difference is that the references do not specifically recite the numerical values for macrodispersion recited in applicants' claims. It would be obvious to one of ordinary skill in the art to practice the inventions of Inoue or Asai or Simonet so as to achieve macrodispersion of .2%. The motivation is that it is within the skill in the art to conduct the methods of these references to achieve a desired degree of dispersion of filler in elastomer. See column 2, line 66 of Inoue. See column 1, line 27 and column 1, line 37 of Asai. See column 1, line 40 of Simonet.

Serial No. 08/823,411

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Any inquiry concerning this communication should be directed to Paul Michl at telephone number (703) 308-2451.

The Examiner's supervisor is Vasu Jagannathan phone number (703) 306-2777. The fax number for this group is (703) 305-3599.

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August 19, 1998


PAUL R. MICHL
PATENT EXAMINER
ART UNIT 156